



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,206	01/09/2001	R. Mark Halligan	77901	1306
24628	7590	07/28/2004	EXAMINER	
WELSH & KATZ, LTD 120 S RIVERSIDE PLAZA 22ND FLOOR CHICAGO, IL 60606			MOONEYHAM, JANICE A	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.	Applicant(s)	
09/757,206	HALLIGAN ET AL.	
Examiner	Art Unit	
Jan Mooneyham	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1) Responsive to communication(s) filed on 09 January 2001.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

4) Claim(s) 1-95 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-95 is/are rejected.  
 7) Claim(s) 81-84, 92-95 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

1. This is in response to the communication filed on January 9, 2001. Claims 1-95 are currently pending in this application.

### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on July 26, 2001 is being considered by the examiner.

### ***Specification***

3. The abstract of the disclosure is objected to because the abstract is over the 150 word limit. Correction is required. See MPEP § 608.01(b).

Abstract of the Disclosure: See MPEP § 608.01(f). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. In an international application which has entered the national stage (37 CFR 1.491(b)), the applicant need not submit an abstract commencing on a separate sheet if an abstract was published with the international application under PCT Article 21. The abstract that appears on the cover page of the pamphlet published by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) is the abstract that will be used by the USPTO. See MPEP § 1893.03(e).

### ***Claim Objections***

4. Claims 81-84, 92-95 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

***Claim Rejections - 35 USC § 112***

5. Claims 4-6, 8-70 and 74-95 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The applicant's specification does not disclose adequate structure for performing the recited function. For example, in claim 19, the applicant talks about a means for calculating from the specified security measures a security measures factor for a trade secret. What is the means for doing the calculation? How is the calculation performed? The applicant has provided no formulas with which the applicant performs the calculation. The applicant has not defined how the security measure factor is determined. The applicant talks about a threshold value in the specification and never really defines how the threshold value is determined. How are the values weighted? How is the net present value of a trade secret calculated? How is the economic benefit factor calculated? How does one characterized whether the trade secret constitutes negative know-how? In claim 22, the applicant claims a means for calculating various weighted values of the six factors using logical and mathematical equations. The applicant has failed to provide the mathematical equations used to perform calculations.

How are the security threats factors calculated?

Therefore, applicant is respectfully requested to specifically point out the means in the claim limitation and the functionality of these means in performing the steps or functions. (See MPEP Section 2181).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 4-6, 8-70 and 74-95 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For example, how is the indexing performed, how are the trade secret drafts converted into trade secret application? How are the security measures specified? How are security threats specified? What are the six factors of a trade secret as enumerated in Section 757 of the First Restatement of Torts? How are the values weighted? What is a combinational trade secret? What constitutes negative know-how? How does one create a specification of the type trade secret using alphabetic, numeric, or alphanumeric fields.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-95 are rejected under 35 U.S.C. 102(e) as being anticipated by Donner (US 6, 263, 314).

Referring to Claim 1-95:

Donner discloses a system for providing documentation, analysis, auditing, and accounting of IP (which includes trade secrets), said system comprising:

- a data processing means (Fig. 1 (6), Fig. 8 (250));
- a user interface means (Fig. 7, Fig. 8 (264));
- a mass data storage means (Fig. 1 (4)(5), Fig. 2);
- a means for indexing (Fig. 3 (indicator collection organizing device));
- a means for storing or archiving (Fig. 1 (4) (5), Fig. 2);
- a means for associating (Fig. 1 (10), Fig. 3 comparison device);
- a means for analyzing (col. 5, lines 5-17);

The language directed to an intended use of the system in a claim for an apparatus or system does not result in a structural or functional difference with respect to the prior art and held not to serve as a limitation on the claim (See *In re Schreiber*, 44 USPQ2d 1429 (CAFC 1997).

8. Claims 1-95 are rejected under 35 U.S.C. 102(e) as being anticipated by Elder (US 6,393, 406).

Elder discloses a system comprising:

- data processing means (Fig. 3 (136));
- user interface (Fig. 1 (20));
- mass data storage means (Fig. 1 (15, 10, 30, 35, 40, 50) Fig. 3 (135))
- printer means (Fig. 3 (137), Fig. 12 (118))

calculating means (Fig. 1 (400), Fig. 12 (772))

comparison or analysis means (Fig. 12 (773))

The language directed to an intended use of the system in a claim for an apparatus or system does not result in a structural or functional difference with respect to the prior art and held not to serve as a limitation on the claim (See *In re Schreiber*, 44 USPQ2d 1429 (CAFC 1997).

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure

The Paten and License Exchange discloses a system with databases, user interface and processor for providing online patent license and exchange.

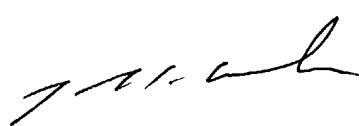
The Washington Post discloses the problems of keeping trade secrets within a company.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jan Mooneyham whose telephone number is (703) 305-8554. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JM



JOHN G. WEISS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600